

statement of ownership under 37 C.F.R. 3.73(b), and thus the application was objected to under 37 C.F.R. 1.172(a).

Statement of Ownership and Consent of Assignee

The Examiner correctly points out the Applicant mistakenly referenced a “substitute consent of the assignee to the reissue application containing the frame and reel number ...” in the response filed February 6, 2002. Indeed, this response actually contained a substitute statement of ownership under 37 C.F.R. 3.73(b). However, an executed “Consent of the Assignee” was previously submitted with the Response to Missing Parts filed April 13, 2001 (along with the prior statement of ownership that inadvertently neglected the frame and reel number). This consent form was signed by Mr. Dan Crouse of Microsoft, who is the same officer that signed the substitute statement of ownership under 37 C.F.R. 3.73(b). Thus, Applicant believes that all the necessary forms (both the statement of ownership and the consent of the assignee) have been submitted in this case. A copy of the originally-filed Consent of the Assignee is included herewith for the convenience of the Examiner.

Alleged Defects in the Reissue Declaration

The Office Action notes that the declaration is defective because the error relied on to support reissue is not an error upon which reissue can be based due to recapture. Applicant again respectfully traverses this alleged defect for the reasons detailed in the following sections relating to recapture. That is, the reissue claims do not seek to recapture subject matter that was surrendered, and thus the statement of error in the original declaration is believed to be accurate and provides a sufficient basis for reissue.

The Reissue Claims Are Not Barred by the Recapture Rule

Initially, it is noted that the citation to the Pannu case in the Final Office Action evidences either a misunderstanding regarding the file history of the original application leading up to this reissue application, or confusion regarding the recapture rule itself. Namely, recapture is an equitable doctrine that prevents an applicant from amending a claim to obtain allowance

and later removing the very same amendment in a reissue proceeding so that the reissue claims are either the same as or broader than the original application claims. As noted in both the Preliminary Amendment accompanying this reissue application, as well as in the prior Amendment and Response, the present reissue claims **do not** present such a case (i.e., the newly added reissue claims are narrower in all aspects than the claims of the original application that were ultimately amended to overcome prior art rejections). The Examiner is urged to review both the Preliminary Amendment and the Amendment and Response to the first Office Action in this case as these documents fully explain why the recapture rule does not apply here. However, Applicant will address the specific Federal Circuit case cited by the Examiner, as well as generally respond again to the Examiner's recapture argument, in order to provide a full response to the Final Office Action.

The Equitable Recapture Doctrine Does Not Apply Where Claims Are Narrowed

The recapture doctrine is usually described only in reported decisions where a reissue applicant has made numerous amendments to the claim language, some arguably broadening the original application claims while others arguably narrowing the original claims. These complicated factual situations can make it difficult to fully understand the application of the recapture rule, although there are several guidelines that have been established by the Federal Circuit to provide clarity. See In re Clement, 45 U.S.P.Q.2d 1161, 1165 (Fed. Cir. 1997) which describes different categories of reissue claims and their applicability to the recapture doctrine:

From the results and reasoning of those cases, the following principles flow: (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

The present reissue claims are an example of category (2) above since the claims are narrower in all aspects than the claims of the original application that were amended to obtain

allowance of the patent. The case of Pannu v. Storz Instruments Inc., 59 U.S.P.Q.2d 1597 (Fed. Cir. 2001), cited by the Examiner in the Final Office Action, is an example of category (3)(a) above. Specifically, in Pannu, a shape limitation of one element of an intraocular lens was added during the original patent prosecution to overcome cited prior art. In a later reissue application, the Applicant successfully deleted this shape limitation while adding new limitations to other elements of the claims. The Federal Circuit found that “the reissued claims were not narrowed in any material respect compared with their broadening.” Id. at 1601. Indeed, the quote that was included by the Examiner in the Final Office Action is more instructive once it is placed in context as below:

In prosecuting the '855 patent, Pannu specifically limited the shape of the haptics to a “continuous, substantially circular arc.” On reissue, he is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections. Id.

Thus, the Applicant in Pannu added a shape restriction to overcome a prior art reference in the prosecution of the original patent and then completely removed that shape reference in the reissue claims. Thus, the reissue claims were just as broad as the original application claims (with respect to the shape of the lens element) and the Court correctly found recapture in that case. However, the present reissue case is easily distinguishable from the facts of Pannu, as summarized in the next section.

The Reissue Claims Are Narrower Than The Original Application Claims

The Examiner correctly summarizes the prosecution of the original '300 patent. For convenience, original application claim 1 of the '300 patent is set forth below:

1. A method for completing a data entry for an active cell of a spreadsheet having a plurality of cells arranged in a grid of rows and columns, comprising the steps of:
 - generating a list of completed data items from a range of said cells having an association with said active cell;
 - defining a partial data entry within said active cell;
 - searching said list of completed data items to identify a suggested completion comprising said partial data entry; and
 - in response to identifying said suggested completion, displaying said suggested completion within said active cell.

This original claim was amended after-final to include a number of additional limitations as found in issued claim 1 of the '300 Patent. Chief among these limitations was the additional step of "identifying a list of completed data items from a search region within said spreadsheet comprising a table of contiguous data-containing cells encompassing said active cell and bordered by empty cells." This limitation was argued as distinguishing the prior art Smith reference. See Amendment B (paper no. 8) which stated in pertinent part:

The search region, as recited by [amended] claim 1, comprises a table of contiguous data-containing cells encompassing the active cell and bordered by empty cells. The Smith reference does not describe searching a database using an active cell's physical association to other data items within the database, but rather, searches the entire database of previously entered data items. As a result, the search region for an active cell has **no defined boundary parameters**. All previously entered database items are considered to be associated with an active cell. (Emphasis added.)

Thus, the original patent claims were amended to define a search region having "defined boundary parameters" in relation to the active cell, and it was this amendment that overcame the citation to prior art references that did not define any search region having defined boundaries (i.e., the prior art references were limited to searching the entire database). On the other hand, the present reissue claims do not attempt to completely remove the requirement of a search region having defined boundary parameters (as was the case in Pannu). Rather, the present reissue claims simply define **alternative** search regions (i.e., different boundaries) than those enumerated in the issued claims of the '300 patent, and thus the present reissue claims do not attempt to recapture the original scope of the application claims. In other words, because the original application claims were interpreted by the Patent Office as failing to provide a search region with any defined boundaries, the reissue claims are narrower than the original patent claims in all respects (even though the reissue claims define different boundaries than those enumerated in the final claims of the '300 patent).

The Recapture Rule Does Not Apply To The Reissue Claims

As summarized above, each of the new claims found in the present reissue application continue to recite a search region with defined boundaries, and thus the new reissue claims are narrower than the claims of the original application. Therefore, the equitable doctrine of recapture does not apply in this case. See above discussion of In re Clement (“if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible”). Of course, the “other rejections” referred to by the Court in Clement are other possible prior art rejections that may be applied against the reissue claims, particularly where the reissue claims are broader than the issued patent claims (as opposed to the original application claims). However, such “other rejections” have nothing to do with the equitable doctrine of recapture, and the Examiner has already found the present reissue claims to be allowable over the previously cited art.

In sum, the quotation from the Pannu case cited in the Final Office Action is inapplicable in this case since the applicant in Pannu was attempting to “recapture the precise limitation he added to overcome prior art rejections” (i.e., he was attempting to remove the shape limitation of the lens element and thereby return the claim to its original scope). In this case, Applicant is not attempting to return the claims to their original scope (i.e., with no defined boundaries for the search region), but rather is only adding claims to define alternative search regions. Thus, the recapture rule simply does not apply. See Whittaker Corp. v. UNR Industries Inc., 15 U.S.P.Q.2d 1742, 1745 (Fed. Cir. 1990) (“Since we hold that the claims of the reissue patent are narrower in scope than the cancelled original claims of the application that resulted in the '882 patent, the '453 [reissue] patent cannot be held invalid under the recapture rule”). See also MPEP § 1412.02 (“patentee is free to acquire, through reissue, claims that are narrower in scope in all aspects than claims canceled from the original application.”); and Ball Corp. v. U.S., 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were canceled from the original application. On the other hand, the patentee is free to acquire, through reissue, claims that are narrower in scope than the canceled claims. If the reissue claims are narrower than the canceled claims, yet broader than the original patent claims, reissue must be sought within 2 years after grant of the original patent.

Conclusion

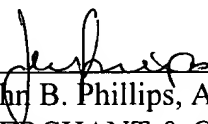
As has been repeatedly noted, the recapture rule does not apply to the pending reissue claims for the simple reason that these claims are narrower than the claims that were "canceled" from the original application. Indeed, the Examiner has determined that the reissue claims are allowable over the same prior art cited in the original application, thereby confirming that the reissue claims are indeed narrower than the originally rejected claims. Thus, it should be clear that the equitable basis for the recapture rule does not apply here since Applicant is not attempting to "recapture" the original scope of the rejected claims.

Due to the prior submission of the consent of the assignee as described above, the reissue application is believed to be in condition for allowance and such action is respectfully requested. Should the Examiner have any remaining issues or concerns, he is urged to contact the undersigned by telephone at (303) 357- 1634 to address those concerns.

Dated: November 5, 2002

Respectfully submitted,




John B. Phillips, Attorney Reg. No. 37,206
MERCHANT & GOULD P.C.
P. O. Box 2903
Minneapolis, MN 55402-0903
(303) 357- 1634